

### **REMARKS/ARGUMENTS**

Reconsideration of this application is requested. Claims 1, 2 and 4-9 will be pending in the application subsequent to entry of this Amendment.

The claims have been amended in order to more particularly point out and distinctly claim that which applicants regard as their invention. More specifically, independent claims 1 and 8 require that the film is formed directly on the metal plate. This feature is described throughout the specification, for instance at page 3, line 21, and the paragraph bridging pages 3 and 4, page 4, lines 5-8, page 6, last line, etc. Further, claims 1 and 8 require that the rubber layer is formed by vulcanization. Vulcanization is disclosed at page 8, lines 1-2.

The rubber used to form the rubber layer is also specified in claims 1 and 8 and this finds basis in the original description for instance at page 7, lines 18-24.

New claim 9 which is directed to the feature that the rubber layer is directly formed on at least one of the opposite surfaces of the metal plate through the film, has been added and basis for this claim will be apparent from the above discussion. Accordingly, the amendments made to the claims do not present added subject matter.

In claim 7, the feature of "a metal or a compound of a metal other than chromium or a chromium compound" unintentionally deleted from claim 7 has been restored. *See* the corresponding passage of claim 1. Therefore, the limitation is added in the present amendment.

The Official Action presents two prior art-based rejections, the first directed to claim 7 only and the second directed to the remaining claims (prior to this Amendment).

The Official Action argues that claim 7 is anticipated by U.S. 5,743,971 to Inoue. The amendments made to claim 7 render this rejection moot.

Inoue discloses as the essential elements: (A) an oxidative substance, (B) a silicate and/or silicon dioxide and (C) at least one member of metal cations of Ti, Zr, Ce, Sr, V, W and Mo; and oxymetal anions and fluorometal anions thereof.

A combination of (A) and (C) of Inoue corresponds to the "mixture of a first acid component and a second acid component" of claim 7. Therefore, Inoue does not disclose "a metal or a compound of a metal other than chromium or a chromium compound" to be reacted with the combination of (A) and (C).

Further, according to new claim 9, the gasket material must include a rubber layer. Since Inoue relates to a Rust Proof Film (title of Inoue), Inoue does not relate to a structure including the "rubber layer", and Inoue does not disclose the "rubber layer" of claim 9.

The withdrawal of this rejection is requested.

Remaining claims 1, 2, 4-6 and 7 are rejected over the newly cited reference to Matsuzaki. This reference describes what is essentially a three component structure of a metal base, for instance a zinc or zinc alloy plated steel sheet or aluminum or an aluminum alloy plated steel sheet. Next comes a composite oxide coating formed on the surface of the steel sheet and finally an organic coating formed on the composite oxide coating; *see* [0018]. This structure, including its intermediate layer of composite oxide, is quite distinct from the structure of the present application and requirements of the claims now under review.

As for claims 1 and 8, these claims require that "the film is formed directly on the metal plate".

In Matsuzaki, a film is formed on a zinc or a zinc alloy plated layer or an aluminum or an aluminum alloy plated layer. When the film is formed on this plated layer, the metallic composition is easily dissolved by the acid and included in the film. The film including the metallic composition originating from the plate layer is likely to be broken by water or oil. So, if Matsuzaki's film is used for a gasket material, the rubber layer can easily become unstuck from the metal plate by the water or the oil in its use environment, an engine.

In addition, Matsuzaki's film has a structure to be hydrolyzed. Therefore, from the outset it is impossible to use Matsuzaki's steel sheet as a gasket material.

Further, amended claims 1 and 8, require that "the rubber layer is bonded by vulcanization". The examiner argues that an organic coating such as polyurethane resin of Matsuzaki corresponds to the rubber layer of claims 1 and 8. Applicants disagree – the organic coating is only coated on the plated layer in Matsuzaki, and the organic coating is not bonded by vulcanization.

In addition, as featured in amended claims 1 and 8, it is required that "a rubber for forming the rubber layer comprises one of NBR, fluoro rubber, silicon rubber, acrylobutadiene rubber, HNBR and EPDM". These materials are not disclosed in Matsuzaki.

SAITO, H. et al.  
Appl. No. 10/659,272  
March 13, 2006

For the above reasons it is respectfully submitted that the claims as amended define subject matter that is both novel and inventive over the disclosures of the cited and applied prior art references. Reconsideration and favorable action are solicited.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_



Arthur R. Crawford  
Reg. No. 25,327

ARC:eaw  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100